

Remarks

Applicants respectfully request entry of the present amendment under 37 C.F. R. §1.116(b) as complying with requirements of form set forth in the previous Office action and as presenting the claims in better form for consideration on appeal, which has been provisionally filed concurrently with this response.

Applicants respectfully request reconsideration of the above-identified application. Claims 19-24, 26-31, 33-39, 41, 44-45, and 47-50 remain in this application. Claims 19, 21, 27-29, 33-34, 36, 39, and 41 have been amended. Applicants respectfully traverse the rejections as conceivably applied to the pending and amended claims.

I. Claim Objections.

Claims 19, 21, 27-29, 33-34, 36, 39, and 41 have been amended to overcome the claim objections noted in the previous Office action. These amendments do not narrow the scope of the claims.

II. Art Rejections

The previously presented claims 19-24, 26-31, 33-39, 41, 44-45, and 47-50 were rejected under 35 U.S.C. § 103(a) as obvious in view of U.S. Patent 6,514,596 to Orologio combined with U.S. Patent 6,355,333 to Waggoner.

Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to independent claim 19 to shift the burden of rebuttal to the Applicant. One of the requirements of a *prima facie* case of obviousness is that the combined prior art reference must teach or suggest *all* of the claim limitations. MPEP §706.02(j).

Neither Orologio nor Waggoner discloses, teaches, or suggests a *perforated insulating sheet* having gas filled cavities, as recited in amended claim 19. Orologio fails to teach perforations at all. Waggoner teaches that “barrier sheet materials” include “perforated polymer films.” (Waggoner; column 1, lines 42-46.) However, Waggoner is describing a *barrier sheet* material, not an *insulating sheet* having gas filled cavities, as recited in amended claim 19.

Since neither reference teaches a perforated insulating sheet, even if Waggoner were combined with Orologio, a *prima facie* case of obviousness is not established because the proposed combination of references does not teach or suggest *all* of the claim recitations. MPEP §2143.03. Thus, Applicant is attacking the *combination* of references as insufficient to establish *prima facie* obviousness.

The previous Office Action states that “it would have been obvious to perforate Orologio’s insulation bubble bubble-pack in the land area . . . then laminate it to a moisture permeable, waterproof backing . . . motivated by the desire to obtain improved moisture permeability and waterproof property.” (Office Action mailed September 25, 2003 at page 3, lines 9-14.)

Yet, neither Orologio nor Waggoner provides any suggestion or motivation to *laminate* the Waggoner barrier sheet material to the Orologio bubble-pack material to improve moisture permeability and waterproof property. Further, neither Orologio nor Waggoner provides any suggestion or motivation to *perforate* the Orologio bubble-pack material to improve moisture permeability and waterproof property.

Rather, the motivation to make the combination of references and further perforate one of the reference’s materials is provided only by reading the present application. However, it is impermissible to use the present application as a source of motivation for modifying the prior art references to attempt to arrive at the presently claimed invention. MPEP 2142. Because there is no cited authority supporting the proposed reason for perforating the Orologio bubble-pack and laminating it to the Waggoner barrier sheet, Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

“The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. The need for specificity pervades this authority.” *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (cites omitted). The factual question of motivation to combine cannot be resolved on “subjective belief and unknown authority.” *Id.* at 1434. The best defense against improper hindsight-based obviousness is the

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requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The dependent claims include additional recitations to those of independent claim 19 and are therefore further patentable over the proposed combination of Orologio and Waggoner.

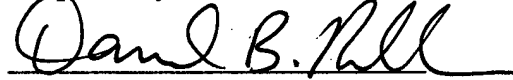
III. Conclusion

In view of the above amendments and these remarks, it is respectfully submitted that the present application is in condition for allowance. A notice to that effect is earnestly and respectfully requested.

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